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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------|-------------|----------------------|---------------------|------------------|
| 09/688,961 | 10/17/2000 | ALAIN BETHUNE | 107615 | 1437 |
| 25944 | 7590 | 01/05/2004 | EXAMINER | |
| OLIFF & BERRIDGE, PLC | | | LORENGO, JERRY A | |
| P.O. BOX 19928 | | | | |
| ALEXANDRIA, VA 22320 | | | ART UNIT | PAPER NUMBER |
| | | | 1734 | |

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/688,961 | BETHUNE, ALAIN | |
| | Examiner | Art Unit | |
| | Jerry A. Lorengo | 1734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-13 and 24-43 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-13 and 24-43 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

| | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1)

Election/Restrictions

Applicant's election with traverse of 1-13, 21, 22 and 24-41 in Paper No. 13 is acknowledged. The traversal is on the ground(s) that the examiner has failed to show that a serious burden exists if the restriction is not made.

This is not found persuasive because the examiner, as set forth in the section (1) of the office action mailed June 9, 2003, has demonstrated that the inventions are distinct (for the reasons set forth therein) and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification." Furthermore, because claims 14-20 are classified as stock materials, a search and/or consideration of those claims would require a more detailed search with concomitant burden.

The requirement is still deemed proper and is therefore made FINAL.

(2)

Claim Rejections - 35 USC § 102

The rejection of claims 1, 6, 9, 10, 24, 25, 26, 31, 34, 35 and 41 under 35 U.S.C. 102(b) as being anticipated by JP 01-202492 to Doi et al., as generally set forth in the office action mailed June 9, 2003, stands

(3)

Claim Rejections - 35 USC § 103

The rejection of claims 12 and 37 under 35 U.S.C. 103(a) as being unpatentable over JP 01-202492 to Doi et al., as set forth in section (2), above, in further view of U.S. Patent No. 4,215,170 to Vilaprinyo Oliva, as generally set forth in the office action mailed June 9, 2003, stands

(4)

The rejection of claims 2, 4, 5, 7, 8, 11, 13, 21, 27, 29, 30, 32, 33, 36, 38 and 39 under 35 U.S.C. 103(a) as being unpatentable over JP 01-202492 to Doi et al., as set forth in section (2), above, in further view of U.S. Patent No. 4,294,641 to Reed et al., as generally set forth in the office action mailed June 9, 2003, stands

(5)

The rejection of claims 3 and 28 under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (4), above, in further view of U.S. Patent No. 5,581,978 to Hekal et al., as generally set forth in the office action mailed June 9, 2003, stands

(6)

The rejection of claims 22 and 40 under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (4), above, in further view of U.S. Patent No. 4,133,723 to Howard et al., as generally set forth in the office action mailed June 9, 2003, stands.

(7)

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 01-202492 to Doi et al., as set forth in section (2), above, in further view of U.S. Patent No. 5,391,247 to Kamen et al. and U.S. Patent No. 1,124,869 to Davis et al.

Doi et al. disclose that the transfer is accomplished by the application of pressure and heat with a heated roller thereby activating the heat activated adhesive layer to bond the decorative and protective resin layers to the target substrate.

Davis et al., also drawn to methods for the hot- marking of substrates with a heat-transfer film, disclose that a pattern of decorative material (gold leaf) may be transferred to a substrate through the use of a relief-patterned gilding iron, (Figures 1 and 3; page 1, column 1, line 32 to column 2, line 90).

It would have therefore been obvious to one of ordinary skill in the art at the time of invention to utilize a relief-patterned gilding iron (a stamp), such as that taught by Davis et al., in place of the heated roller of Doi et al. motivated by the fact that Kamen et al., also drawn to methods for the hot- marking of substrates with a heat-transfer films, disclose that the transfer film may be compressed against the substrate by means of a stamp, roller or any other suitable instrument known in the art for this purpose (column 3, lines 6-9).

(8)

Response to Amendments and Arguments

The amendments and arguments filed October 9, 2003 are acknowledged. The addition of new claims 42 and 43 are acknowledged and have been rejected as set forth in section (7), above.

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Applicant's arguments have been fully considered but they are not persuasive. The applicant's main argument is that Doi et al. fail to teach the method step of "applying pressure and heat to the backing layer at a location where it is desired to transfer the decoration layer onto the article, the varnish layer being transferred locally onto the article together with the decoration layer." The examiner respectfully disagrees. Doi et al. disclose that the transfer sheet is applied to the substrate at the location desired and that heat and pressure are applied in that region to transfer the varnish and decoration layers at that location. It appears that the applicant is arguing that the transfer occurs at a discrete location of the substrate by applying heat and pressure to a discrete area of the transfer sheet, such as would be accomplished by the use of the relief-patterned gilding iron set forth in applicant claims 42 and 43.

Claims 1 and 26, however, convey no such limitations and remain anticipated by Doi et al. Furthermore, the rejections set forth in sections (3) through (6), above, continue in force. In addition, the applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(9)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(10)

Applicant is encouraged to **FAX After Final Amendments** (37 CFR 1.116) to expedite delivery to the Examiner. The Group 1734 Facsimile number is **(703) 872-9306**. A duplicate

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mailed copy of the facsimile transmission is **not required** and will only serve to delay the processing of your application.

If the applicant prefers to mail in After Final correspondence it is highly recommended that such be mailed to **BOX AF** which will also facilitate processing from the mailroom and within Group 1700.

(11)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. Please note that all patent application related correspondence transmitted by FAX must be directed to the central FAX number at 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

J.A. Lorengo
Primary Examiner
AU 1734
December 24, 2003